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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURENCE E. ENGLANG, HOWARD J. GLASER,
and ROBERT D. MOYER

Appeal 2008-0597
Application 09/591,035
Technology Center 2100

Decided: July 29, 2008

Before JAMES D. THOMAS, JAY P. LUCAS,
and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner final rejection of claims 1 through 24. We have jurisdiction under 35 U.S.C. 6(b).

As best representative of the disclosed and claimed invention,
independent claim 1 is reproduced below:

1. A compute-implemented method of adapting a transaction-based mainframe application to process transactions over a network, said transaction-based mainframe application comprising source code describing a transaction and information related to the transaction, hereinafter related information, said method comprising:

scanning the source code of the transaction-base mainframe application to identify the transaction and the related information, wherein the transaction-based mainframe application is unable to process transactions over a World Wide Web (Web);

storing in a database the related information identified in the scan of the source code, hereinafter identified information;

extracting from the database parameter definitions describing a communication of information by the transaction, hereinafter extracted information;

identifying a parameter usage type for each parameter, said parameter usage type selectable from the parameter usage type set comprising input, output, input/output, and unreferenced;

displaying the transaction and a subset of the related information and extracted information;

allowing a user to select the transaction; and

using the identified information and extracted information to package the user-selected transaction in a form compatible with a connector building tool by generating a communication area file that may be parsed by the connector building tool to build a connector and a documentation file that provides documentation about the communication area file, wherein the connector enables the transaction-based mainframe application to process transactions over the web by enabling the transactions to be passed from a web application server to the transaction-based mainframe application.

The following references are relied on by the Examiner:

O'Brien	US 6,351,776 B1	Feb. 26, 2002 (Filing date May 12, 2000)
Helgeson	US 2002/0073236 A1	Jun. 13, 2002 (Effective filing date Jan 14, 2000)

Claims 1 through 24 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Helgeson in view of O'Brien.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

We reverse the outstanding rejection under 35 U.S.C. § 103 because the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. Presently, speculation and conjecture must be utilized by us and by the artisan inasmuch as the claims on appeal do not adequately reflect what the disclosed invention is. Note *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). Note also *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Because we conclude that there are significant ambiguities with respect to each of the independent claims on appeal, and therefore their respective dependent claims, we reject claims 1 through 24 under the second paragraph of 35 U.S.C. § 112 within 37 C.F.R. § 41.50(b). There appears to be significant ambiguities in the claims such as to lead to speculation and/or presentation of future acts that may never occur. Each independent claim 1, 9, and 17 in some manner merely allows a user to select a transaction but

does not specifically state that the user does select a transaction. The last long clause of each claim relates to recitations such as “to package,” “to build,” “to be passed.” This clause also includes a recitation that a file “may be parsed.” The end of this clause also recites the potential enablement of certain features but not a positive statement of them being enabled. Thus, the metes and bounds of the independent claims, and therefore their respective dependent claims, are not reasonable determinable since the claims encompass acts or functions that may never occur and relate to acts or functions that are merely permissive or not recited in the present tense.

Because these ambiguities lead to the lack of definite claims on appeal, the application of the prior art relied upon by the Examiner becomes merely speculative. Once properly definite claims are presented as a result of subsequent prosecution in this application, the actual prior art applied by the Examiner in this appeal may also be appropriate should that arise. Additionally, any other prior art may be appropriate to apply as well.

At least with respect to claims 9 through 16, we reject these claims under 35 U.S.C. § 101 as being directed to a non-statutory subject matter. On its face, independent claim 9 may purport to recite an article of manufacture. The article of manufacture is said to comprise a computer-readable storage medium having a computer program embodied in the medium. In accordance with the teachings at Specification page 10, lines 14 through 21 and the discussion in the paragraph bridging Specification pages 14 and 15, the claimed article of manufacture is stated to be a computer program itself, such as the computer program product itself embodying an article of manufacture at Specification page 14, lines 23. Moreover, the

discussion in this paragraph contemplates embodying the computer program product in the form of the transmission of data or signals. No authority that we are aware of permits, within 35 U.S.C. § 101, the claiming of a computer program itself as an article of manufacture. Any signal or transmission embodiment is also proscribed by the reasoning in *In re Nijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007).

We also reject claims 1 through 24 under the enablement provision of 35 U.S.C. § 112, first paragraph. As to the enablement issue, the specification of the patent must teach those skilled in the art how to make and use the claimed invention without undue experimentation. *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir.), *cert. denied*, 118 S.Ct. 397 (1997). This same case indicates that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the disclosure. Enablement is also not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly excessive. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987).

As to the enablement rejection, the subject matter in the last clause in each claim on appeal recites the packaging of a user-selective transaction in a form compatible with a connector building tool. Independent claim 17 in fact even recites “a packaging computer program” which is recited only functionally in independent claims 1 and 9, for example. In figure 2 the element 210 labeled “TOOL” is discussed beginning at the top of Specification page 11 as an analysis/packaging tool, which “packages” user selective transactions in a form consumable for web component connector

building tools 215. This tool 210 in figure 2 is merely depicted as a rectangular block diagram with certain broadly defined functions of packaging associated therewith as just indicated. There is no disclosure as to the details in terms of flow charts or functionality or actual computer code in which to embody this tool. The absence of any disclosure as to the details of this functionality clearly leads to the conclusion that it would require undue experimentation for an artisan to make and use the claimed invention at least to the extent the packaging is required in each claim on appeal.

Lastly, we reject claims 1 through 24 on appeal as failing to fulfill the written description requirement of 35 U.S.C. § 112, first paragraph. The Court of Appeal for the Federal Circuit has held that “[t]o fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364 (Fed. Cir. 2003) (citations omitted). Our reviewing court has cautioned, however, that “[t]he disclosure as originally filed does not . . . have to provide in haec verba support for the claimed subject matter at issue.” *Id.* at 1364. “Although [the applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989) (citations omitted). Put another way, “the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath, Inc. V. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The written description, although

it need not include information that is already known and available to the experienced public, must be in sufficient detail to satisfy the statutory requirements, employing “[w]ords, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” *Space Systems/Loral, Inc. v. Lockheed Martin*, 405 F.3d 985, 987 (Fed. Cir. 2005) (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). Finally, “[p]recisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis.” *Eiselstein v. Frank*, 52 F.3d 1035, 1039 (Fed. Cir. 1995) (citation omitted).

The focus of this issue is upon the wherein clause at the end of each independent claim on appeal that effectively recites “wherein the connector enables the transaction-based mainframe application to process transactions over the web by enabling the transactions to be passed from a web application server to the transaction-based mainframe application.” This language was introduced by the amendment submitted on March 2, 2006. The quoted feature was not recited in the original claims or specification, thus, leading us to conclude that, in accordance with the above-noted case law, Appellants were not in possession of that aspect of the presently claimed invention as of the filing date of this application. The remarks regarding the associated amendment beginning at page 8 do not justify or explain any basis for this amendment from any originally filed application material.

Indeed, the continued use of the word “over” in the specification only contemplates the propagation of a transaction “to” the web but not from it. The discussion at Specification page 4, lines 15 and 16 indicates problems known in the art with respect to “bringing mainframe applications out to the web.” The discussion at the bottom of Specification page 10, lines 23 through 26 indicates a desire to link a transaction-based application on the mainframe to the Internet 32 and/or World Wide Web. Note also the discussion at Specification page 12, line 27 through page 13, line 3. Whereas the present recitation we quoted earlier contemplates or recites the reception of transactions from a web application server to a transaction-based mainframe application, that is, transactions from the web, the disclosed invention only contemplates the transmission of such transactions over/to the web and not from it. The Specification as filed does not contemplate receiving transactions from a web applications server to the transaction-based mainframe application from a web or any kind of network-based connectivity.

In summary, we have pro forma reversed the outstanding rejection of claims 1 through 24 under 35 U.S.C. § 103. Within the provisions of 37 C.F.R. 41.50(b), we have rejected these claims under the second paragraph of 35 U.S.C. § 112; under the enablement provision of the first paragraph of 35 U.S.C. § 112; and under the written description portion of 35 U.S.C. § 112, first paragraph.

Separately, we have also rejected claims 9 through 16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
- (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

pgc

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